

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed December 27, 2004. In order to advance prosecution of this Application, Claims 2 and 12 have been amended. Applicant respectfully requests reconsideration and favorable action in this Application.

Claims 2-12 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Claims 2, 4, 6-9, and 12 have been amended to address the connection matters raised by the Examiner. Therefore, Applicant respectfully submits that Claims 2-12 are in accordance with 35 U.S.C. §112, second paragraph.

Claims 2-12 stand rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. Applicant respectfully traverses this rejection. However, to expedite issuance of a patent from this Application, Applicant has amended Independent Claims 2 and 12 to recite that the computer-implemented method and system are performed by a computer and code and that each of the recited method steps and system elements are performed using a computer and code executed by a computer.

The patent laws define patentable subject matter as "any new and useful process, machine, manufacture or composition of matter, or any new and useful improvement thereto." See 35 U.S.C. § 101. When an abstract idea is reduced to a practical application, the abstract idea no longer stands alone if the practical application of the abstract idea produces a useful, concrete, and tangible result. This then satisfies the requirements of 35 U.S.C. § 101. See *In re Alappat*, 33 F.3d 1526, 1544, 31 U.S.P.Q. 2d 1545, 1557 (Fed. Cir. 1994); see also *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1373, 47 U.S.P.Q. 2d 1596, 1601-02

(Fed. Cir. 1998). While an abstract idea by itself may not satisfy the requirements of 35 U.S.C. § 101, an abstract idea when practically applied to produce a useful, concrete, and tangible result satisfies 35 U.S.C. § 101. See *AT&T Corp. v. Excel Comm. Inc.*, 172 F.3d 1352, 1357, 50 U.S.P.Q. 1447, 1452 (Fed. Cir. 1999) (stating that as technology progressed, the CCPA overturned some of the earlier limiting principles regarding 35 U.S.C. § 101 and announced more expansive principles formulated with computer technology in mind); see also *In re Musgrave*, 431 F.2d 882, 167 U.S.P.Q. 280 (CCPA 1970) (cited by the Federal Circuit in *AT&T Corp.*, 172 F.3d at 1356). Thus, producing a useful, concrete, and tangible result is the key to patentability according to *State Street* and other applicable case law.

"Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. 101." M.P.E.P. § 2106. Indeed, a method or process remains statutory even if some or all of the steps therein can be performed in the human mind, with the aid of the human mind, or because it may be necessary for one performing the method or process to think. See *In re Musgrave*, 431 F.2d at 893, 167 U.S.P.Q. at 289. As stated by the Federal Circuit in *State Street* and as explicitly confirmed in the M.P.E.P., "[T]ransformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula, or calculation, because it produces 'a useful, concrete, and tangible result' -- a final share price momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities and in subsequent trades."

State Street, 149 F.3d at 1373, 47 U.S.P.Q. 2d at 1601-02;
M.P.E.P. § 2106.

Claim 2 shows a concrete and tangible result in the technological arts through the generation by a computer of a graphical representation of an overall architecture for a business and the generation by the computer of a plan for implementation and deployment of future information technology among the manageable entities for display by the computer within the graphical representation of the overall architecture. Claim 12 shows a concrete and tangible result within the technological arts through code generation of an overall architecture for the business and code generation of a plan for implementation and deployment of future information technology among manageable entities of the business with graphical display by the code of the overall architecture and graphical display by the code of how the future information technology is to be implemented and deployed within the overall architecture in accordance with the generated plan. The practical application of the claimed invention is the ability to develop an overall architecture by a computer for a business that takes into account the future information technology needs of the business according to the manageable entities within the business and the existing information technology for each manageable entity in order to determine how the future information technology is to be deployed among the manageable entities of the business. The overall architecture and how the plan for implementing and deploying the future information technology therein can be determined and graphically displayed by the computer to provide a meaningful perspective as to how the manageable entities interrelate. Thus, the claimed invention is directed to a computer and code that provide a useful and concrete tangible

result of converting existing information technology for each manageable entity into future information technology needs for implementation and deployment among the group of manageable entities. Therefore, Applicant respectfully submits that Claims 2-12 are in accordance with 35 U.S.C. §101.

Although Applicant believes Claims 2-12 are directed to patentable subject matter without amendment, to expedite issuance of a patent from this Application, Applicant has amended Independent Claims 2 and 12 to make it even more clear that these claims are directed to computer-implemented methods and systems. For at least these reasons, Applicant respectfully requests reconsideration and allowance of Claims 2-12.

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CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests full allowance of Claims 2-12.

The Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 05-0765 of Electronic Data Systems Corporation.

Respectfully submitted,
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